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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/924,101 | 08/07/2001 | Stephen K. Farrand | 1231-220 | 1891 |

32905 7590 11/22/2005

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EXAMINER

HELMER, GEORGIA L

ART UNIT PAPER NUMBER

1638

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,101

Applicant(s)

FARRAND ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 9-33 and 36-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7Dec2001.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Status of the Claims

1. The Office acknowledges receipt of Applicants Response; dated 4 August 2005.
2. Applicant has requested amendment of claim 1. Claims 1-8, 34 and 35 are pending, and are examined in the instant action.
3. This action is made FINAL necessitated by Applicant's amendment.
4. This application contains claims 9-33 and 36-43 drawn to an invention nonelected with traverse in the Response of 23 July 2003. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
5. All rejections not addressed below have been withdrawn.
6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

7. Claims 1 and 3 remain rejected under 35 U.S.C. 102(b) as being anticipated by Recorbet, et. al. , Conditional Suicide system of Escherichia coli released into soil that uses the Bacillus sacB gene, 1993, Applied and Environmental Microbiology, Vol. 59, No. 5, May 1993, pages 1361-1366, for reasons of record set forth in the Office Action of 5 November 2003.

Applicant traverses saying primarily (Response, p. 8) that Recorbet, et. al. teach using an inducible regulatory sequence operatively linked to a nucleotide sequence encoding a levansucrase contained within the genome of E. coli for the purpose of

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controlling microorganism populations in soil, wherein the "instant invention teaches the use of an inducible regulatory sequence operatively linked to a nucleotide sequence encoding a levansucrase contained within the genome of *A. tumefaciens* or *A. rhizogenes* for the purpose of removing of the *A. tumefaciens* or *A. rhizogenes* from the plant system once the gene or genes of interest have been transferred from the bacteria to the plant cells", that the instant invention obviates the use of antibiotics typically used to eliminate *Agrobacterium* from plant transformation systems, and therefore the present invention is different and novel from Recorbet, et. al.

Applicant's traversal is unpersuasive. Applicant's argument is not in accord with the scope of the claims, which are drawn to "gram-negative bacterium". Only claims 4 and 5 are limited to *Agrobacterium*. Furthermore, the claimed invention is drawn to product claims, not method claims, as Applicant seems to imply.

8. Claim 2 remains rejected under 35 U.S.C. 102(b) as being anticipated by Fouet, et. al., Secretion-expression vectors for *Bacillus subtilis* using the levansucrase gene signal sequence, Canada 1, 270,779, issued 26 June 1990, for reasons of record set forth in the Office Action of 5 November 2003.

Applicant traverses saying primarily that Fouet teach the use of an inducible regulatory sequence other than *SacR* operatively linked to a nucleotide sequence encoding a partial levansucrase gene, where as the instant invention is directed to the use of the entire levansucrase gene.

Applicant's traversal is unpersuasive. The instant claims are drawn to "an inducible regulatory sequence other than *sacR* operatively linked to a nucleotide

sequence encoding a levansucrase". The claim language is broadly interpreted to include nucleotide sequences encoding fragments of levansucrase, as well a complete coding sequences. Furthermore, the claimed invention is drawn to product claims, not method claims, as Applicant seems to imply.

9. Claims 4 and 5 remain rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton, US 5,733,744, issued 31 March 1998, for reasons of record set forth in the Office Action of 5 November 2003.

Applicant traverses saying primarily that (Response, p. 9) Hamilton teaches the use of the sacB gene as a positive selection marker, whereas the instant invention does not involve the use of the sacB gene as a marker, using it rather as a method of eliminating Agrobacterium after gene transfer.

Applicant's traversal is unpersuasive. The instant claims are product claims, not method claims. Clearly claims 1, 3, 4 and 5 read on the cited prior art.

Claim Rejections - 35 USC § 103

10. Claims 1,3, 6-8 and 34-35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Recorbet et. al. as applied to claims 1 and 3 above, and further in view of applicant's admitted prior art (pages 5, 7, 8, 9, 10, and 11), for reasons of record set forth in the Office Action of 5 November 2003.

Applicant traverses saying primarily (Response, p. 10 bridging to p.11) that Recorbet, et. al. teach using an inducible regulatory sequence operatively linked to a nucleotide sequence encoding a levansucrase contained within the genome of E. coli for the purpose of controlling microorganism populations in soil, wherein the "instant

invention teaches the use of an inducible regulatory sequence operatively linked to a nucleotide sequence encoding a levansucrase contained within the genome of *A. tumefaciens* or *A. rhizogenes* for the purpose of removing of the *A. tumefaciens* or *A. rhizogenes* from the plant system once the gene or genes of interest have been transferred from the bacteria to the plant cells", that the instant invention obviates the use of antibiotics typically used to eliminate *Agrobacterium* from plant transformation systems, and therefore the present invention is different and novel from Recorbet, et. al.

Applicant's traversal is unpersuasive. The instant claims are product claims, not process claims. Applicant arguments appear to deal with the use of the product, rather than the product itself.

REMARKS

11. No claim is allowed.
12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 571-272-0796. The examiner can normally be reached on M-Th, 10:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 571-272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Georgia Helmer PhD
Patent Examiner
Transgenic Plants—art unit 1638
2 November 2005


ELIZABETH MCELWAIN
PRIMARY EXAMINER